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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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08/680,002 07/08/96 MILLER

EXAMINER

ASMI/1220
OSTROLEK, FABER GENA AND SUFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8403

ART UNIT	PAPER NUMBER
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REMARKS

9

DATE MAILED:

12/23/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 9/29/97.

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-27 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-27 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Art Unit: 1308

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyanohara et al. ('466) in view of Komline and Applicants' disclosure at pages 10-11 for the reasons as set forth in the prior Office Action.

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4. Applicant's arguments filed September 29, 1997 have been fully considered but they are not persuasive.

Applicants argue that Miyanohara et al. ('466) does not address the problem confronted by Applicants, namely reduction of odorous gas release and acid gas release from sewerage and waste water collection systems, while preserving the beneficial bacteria in the system by introducing relatively insoluble magnesium oxide and/or magnesium hydroxide into the contaminated water to attain a specific pH. While Miyanohara et al. does disclose adding a magnesium compound together with lime and an iron salt to improve the filtering characteristics of sludge, it is clear that the sludge treated by Miyanohara et al. is readable on "sewerage or waste" water as is instantly claimed and that such types of sludge will inherently contain compounds that can be reduced to form acid gas, and are thus the types of materials that will present odorous gas and/or acid gas release problems. Furthermore, Komline discloses that odor problems can be reduced in sewerage and waste water by introduction of calcium hydroxide into such materials. Thus, it is submitted that the magnesium compound added in Miyanohara et al. will inherently have the effect of reducing odors in a manner similar to the effect of calcium hydroxide added in Komline. That the references cited by the Examiner appear to address a different problem as that which Applicants attempt to address is not particularly convincing since Komline clearly suggests that odor problems may be controlled by addition of calcium hydroxide whether that is the main problem confronted by Komline or not. Furthermore, Applicants have not demonstrated that a magnesium compound as disclosed by Miyanohara et al. will not

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inherently have the effect as taught by Komline of the addition of the calcium hydroxide. The Examiner continues to maintain that the use of the commercially available "THIOGUARD" product would have been an obvious substitute to the composition used in Miyanohara et al. since "THIOGUARD" contains the essential ingredients that are added by Miyanohara et al. and would thus have the inherent effect of reducing acid gas and odorous gas release as suggested above. Applicants have simply failed to rebut the primary contention by the Examiner that where the prior art suggests adding a magnesium compound, albeit for a different purpose to waste water and sewerage, and the prior art also recognizes that alkaline addition to waste water and sewerage can be controlled by alkaline addition, that it would have been obvious to the person having ordinary skill in the art, at the time that the invention was made, to have added a magnesium compound-containing composition to control acid gas and odorous gas release from sewerage and waste water.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil M. McCarthy whose telephone number is (703) 308-3842.


NEIL MCCARTHY
PRIMARY EXAMINER
GROUP 1300

nmn

December 22, 1997